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**FACSIMILE COVER SHEET**

**Examiner:** Raymond K. Covington **Group:** 1625

**Date:** August 4, 2006

**Client Code:** 3211

**Facsimile No.:** 571-273-8300

**From:** Booyong S. Lim, Reg. No. L0200

**Subject: Paper:** Reply/Response to Interview Summary

**Docket No.:** 3211.1004-021

**Applicants:** Keizo Koya, *et al.*

**Serial No.:** 10/849,978

**Filing Date:** May 20, 2004

Number of pages including this cover sheet: 9

Please confirm receipt of facsimile: Yes XX No     

**Comments:**

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08/4/06

DOCKET NO. 3211.1004-021

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Applicants: Keizo Koya, Lijun Sun, Mitsunori Ono, Weiwen Ying and Hao Li

Application No.: 10/849,978 Group: 1625

Filed: May 20, 2004 Examiner: Covington, Raymond K.

Confirmation No.: 8629

For: 1-GLYOXYLAMIDE INDOLIZINES FOR TREATING CANCER

CERTIFICATE OF MAILING OR TRANSMISSION	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, or is being facsimile transmitted to the United States Patent and Trademark Office on	
8/04/2006	<i>Mary J. Dawson</i>
Date	Signature
Mary J. Dawson	
Typed or printed name of person signing certificate	

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir.

Transmitted herewith is a Reply/Response to Interview Summary for filing in the above-identified application.

- ☐ Small entity status of this application under 37 C.F.R. 1.9 and 1.27 has been established by a Small Entity Statement previously submitted.
- ☐ A Small Entity Statement to establish small entity status under 37 C.F.R. 1.9 and 1.27 is enclosed.

10/849,978

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The claims fee has been calculated as shown below:

					SMALL ENTITY		OTHER THAN SMALL ENTITY		
	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NO. PREVIOUSLY PAID FOR	PRESENT EXTRA	RATE	ADDIT. FEE	OR	RATE	ADDIT. FEE
TOTAL	26	MINUS *	26	0	X \$25	\$		X \$50	\$ 0
INDEP	2	MINUS **	3	0	X \$100	\$		X \$200	\$ 0
<input type="checkbox"/> FIRST PRESENTATION OF MULTIPLE DEP. CLAIM					X \$180	\$		X \$360	\$
					TOTAL= \$ 0			TOTAL= \$ 0	

\* not fewer than 20  
\*\* not fewer than 3

The Application Size Fee has been calculated as shown below:  
(Effective for cases filed on or after December 8, 2004)

Actual Sheets (Including current amendment)	Highest No. of Sheets Paid For (At least 100)	No. of Additional Units Required (Increments of 50 sheets)	SMALL ENTITY		OTHER THAN SMALL ENTITY		Payment Sufficient for up to
			Rate	Total Amount Owed	Rate	Total Amount Owed	
68	100	0	X \$125	\$[ ]	X \$250	\$[ ]	100 Sheets

#### Petition for Extension of Time

[ ] Applicant hereby petitions to extend the time to respond to the [ ] dated [ ] for [ ] month(s) from [ ] to [ ]. The appropriate fee is set forth below.

10/849,978

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**Please charge Deposit Account No. 08-0380 for the following fees:**

☐ Petition for [ ] month Extension of Time \$ \_\_\_\_\_  
☐ Claims Fee \$ \_\_\_\_\_  
☐ Application Size Fee \$ \_\_\_\_\_  
☐ Other Fees: \_\_\_\_\_  
\$ \_\_\_\_\_  
\$ \_\_\_\_\_  
TOTAL: \$ 0

**A check is enclosed in payment of the following fees:**

☐ Petition for [ ] month Extension of Time \$ \_\_\_\_\_  
☐ Claims Fee \$ \_\_\_\_\_  
☐ Application Size Fee \$ \_\_\_\_\_  
☐ Other Fees: \_\_\_\_\_  
\$ \_\_\_\_\_  
\$ \_\_\_\_\_  
TOTAL: \$ 0

☒ Please charge any deficiency or credit any overpayment in the fees that may be due in this matter to Deposit Account No. 08-0380.

Respectfully submitted,

HAMILTON, BROOK, SMITH &amp; REYNOLDS, P.C.

By Booyong Shim  
Booyong Shim Lim  
Registration No.: L0200  
Telephone (978) 341-0036  
Facsimile (978) 341-0136

Concord, Massachusetts 01742-9133

Dated: August 4, 2006

@PFD:esktop\..ODMA/MHODMA/HBSR05;.iManage:641348;1  
SGD/BSL  
08/04/06

PATENT APPLICATION  
Attorney's Docket No. 3211 1004-021

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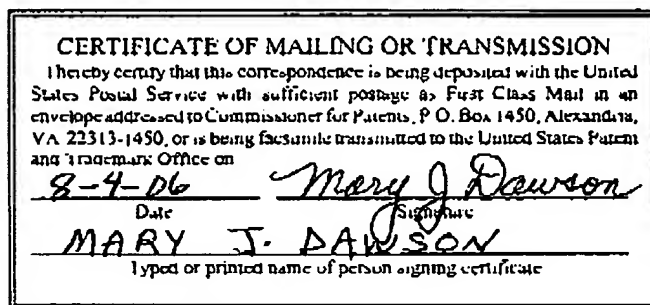
Applicant: Keizo Koya, Lijun Sun, Mitsunori Ono, Weiwen Ying and Hao Li

Application No.: 10/849,978 Group: 1625

Filed: May 20, 2004 Examiner: Covington, Raymond K.

Confirmation No.: 8629

For: 1-GLYOXYLAMIDE INDOLIZINES FOR TREATING CANCER

Reply/Response to Interview Summary

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This Reply/Response to Interview Summary is being filed in response to the Office Action mailed from the U.S. Patent and Trademark Office on May 04, 2006 and in response to the Interview Summary dated August 3, 2006 in the above-identified application.

Applicants' Attorney, Steven G. Davis, and Applicants' Agent, Booyong S Lim, would like to thank Examiner Raymond K. Covington and Examiner Thomas McKenzie for the telephonic interview held on August 1 for the above-identified application. During the interview, an agreement was reached: the rejection under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph and the double patenting rejection would be withdrawn; method claims would be allowed upon an amendment to the claims to limit the method claims to treating breast cancer, and this amendment would be

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done by Examiner Covington via Examiner's Amendment, and accordingly, there would be no longer an outstanding Reply for the application. Although an agreement was reached during the interview to limit the method claims to treating breast cancer, it is noted that Applicants do not hereby abandon or waive any rights in the subject matter associated with the canceled cancer types.

Applicants have received an Interview Summary dated August 3, 2006 for the interview of August 1, 2006. Applicants have noticed that the Interview Summary was not signed by the Examiner. Applicants respectfully request that the Examiner sign the enclosed Interview Summary and resend the signed Interview Summary to Applicants' Attorney. Also, Applicants respectfully request that the Examiner confirm that Applicants are no longer required to reply to the currently outstanding Office Action based upon the agreement reached during the interview of August 1, 2006 in the signed Interview Summary.

Respectfully submitted,

HAMILTON, BROOK, SMITH & REYNOLDS, P.C.

By Booyong S. Lim  
Booyong S. Lim  
Registration No. L0200  
Telephone: (978) 341-0036  
Facsimile: (978) 341-0136

Concord, MA 01742-9133

Dated: August 4, 2006



**FAX**

**Patent Technology Centers**

**Facsimile Transmission**

**To:**                      **Name:**                      **Steven Davis**  
                              **Company:**  
                              **Fax Number:**                      **919783410136**  
                              **Voice Phone:**

**From:**                      **Name:**                      **Raymond Covington**  
                              **Official Fax Number:**                      **(571) 273-8300**  
                              **Official After Final Fax Number:**                      **(571) 273-8300**  
                              **Voice Phone:**                      **(703) 308-4704**

37 C.F.R. 1.6 sets forth the types of correspondence that can be communicated to the Patent and Trademark Office via facsimile transmissions. Applicants are advised to use the certificate of facsimile transmission procedures when submitting a reply to a non-final or final Office action by facsimile (37 CFR 1.8(a)).

**Fax Notes:**

Enclosed are the Interview Summaries for 10/849979, 10/388322, 10/319401

Date and time of transmission: Thursday, August 03, 2006 12:56:12 PM  
Number of pages including this cover sheet: 10

<b>Interview Summary</b>	Application No	Applicant(s)
	10/849,978	KOVA ET AL
	Examiner	Art Unit
	Raymond Covington	1625

All participants (applicant, applicant's representative, PTO personnel):

(1) Raymond Covington.

(3) Steven Davis.

(2) Thomas McKenzie.

(4) Boovong Lim.

Date of Interview: 01 August 2006.

Type: a) ☐ Telephonic b) ☐ Video Conference

c) ☐ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☒ No

If Yes, brief description \_\_\_\_\_

Claim(s) discussed 1 2 5-7 11-13, 20, 21, 24, 25 and 28-35

Identification of prior art discussed: none.

Agreement with respect to the claims f) ☒ was reached. g) ☐ was not reached h) ☐ N/A

Substance of interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: It was determined that method claims limited to treating breast cancer based on example 11 of the specification page 46 would be allowable. Upon reconsideration and discussion the 112 2<sup>nd</sup> rejection has been withdrawn and a Terminal disclaimer has been filed with respect to the double patenting rejection. Accordingly, claims upon amendment would be allowed.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN A NON-EXTENDABLE PERIOD OF THE LONGER OF ONE MONTH OR THIRTY DAYS FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

\_\_\_\_\_  
Examiner's signature, if required



### Summary of Record of Interview Requirements

#### Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record

A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

#### Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111-1.135. (35 U.S.C. 132)

#### 37 CFR § 1.2 Business to be transacted in writing

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicant or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiner's Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Content" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case. It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted.
- 2) an identification of the claims discussed.
- 3) an identification of the specific prior art discussed.
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner.
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner.  
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general result or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

#### Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.